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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/207,954	12/09/1998	YU SUNG (EDUARDO) YEH	733-003	7476

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1940 DUKE STREET
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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/207,954

Applicant(s)

YEH ET AL.

Examiner

Raquel Alvarez

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-- Th MAILING DATE of this c mmunication appears on the cover sheet with th c rrespondenc address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2002 .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-37, 45 and 46 ~~46 and 47~~ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-37, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____ .
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

1. This communication is in response to communication filed on 11/8/2002.
2. Claims 1-34 and 38-44 have been cancelled. Claims 35-37 and 45-46 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 35-37 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over publication, titled, Mendler "Competition drives operators toward retail innovation" hereinafter Mendler.

With respect to claim 35, Mendler teaches receiving a telephone call from a Caller at said server (i.e. the customer calls MCI and provide the numbers of their closest friends)(page 3, paragraphs 4 and 5); querying said caller by said server for a third-party telephone number(page 3, paragraphs 4 and 5); receiving said third-party telephone number (i.e. the system receives the third-party telephone numbers to enable the customer to receive discounts calls on those specified numbers)(page 3, paragraphs 4-5).With respect to establishing by said server a telephone call between said caller and the third party and delivering to said caller and said third party a marketing message during said telephone conference call. Since, the MCI system is

partly responsible for taking 5 percent of AT&T's market share(page 3, paragraph 4) and since it is well known to place conference calls that deliver marketing messages. For example, mortgage companies would call the individuals responsible for decision making by conference calls to deliver marketing message that would motivate both parties to agree on certain specifics of a proposed deal or contract. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included delivering a conference marketing message to the friends and family of the customer because such a modification would save time by enabling the MCI operators to deliver the same message to the two parties at the same time.

Claim 36 differs from claim 35 in that it further recites receiving a call from a caller having a calling card, said calling card having a predetermined number of minute credits associated with it. Official notice is taken that is old and well known for callers to place phone calls with calling cards said calling cards have a predetermined number of minutes based on the money amount purchased. It would have been obvious to a person of ordinary skill in the art a the time of Applicant's invention to have included using a calling card because such a modification would enable the caller to prepay for the call ahead of time.

Claim 37 further recites adding an additional number of minutes credits to said calling card when said marketing message is delivered. Official notice is taken that is old and well known to credit or pay customers for their attention to advertisements. It would have been obvious to a person of ordinary skill in the art a the time of Applicant's invention to have included adding a credit to said calling cards when said marketing

message is delivered because such a modification would motivate the customers to listen to the message.

Claims 45 and 46 further teaches delivering the marketing message based on demographic information of the caller. Official notice is taken that it is old and well known in marketing to target advertisements based on demographic information of a person. For example, a couple with children might receive a baby food commercial to induce the customer to buy a needed product. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included delivering the marketing message based on demographic information of the caller because such a modification would produce the above mentioned advantage.

Response to Arguments

4. The Examiner is providing a reference to support the Official Notice that delivering a marketing message to a 2 parties during a conference call is well known. **Riddle teaches a system and method which enables teleconference members to share files during a conference call** (Abstract). A file sharing accessory allows advertisements (205) to be viewed by the 2 parties. The Examiner asserts that the MCI Friends and Family System collects the telephone number of the caller's friends and family in order to deliver a marketing message to induce the friends and family to join MCI (page 3, 7th paragraph) therefore given the Reese reference it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Reese of delivering a marketing message during a teleconference call to the 2 parties because such a modification would allow for the

caller and the Friend and Family to share the advertisements during the teleconference call and to speak and therefore communicate with each other (in Reese, col. 1, lines 1-14).

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

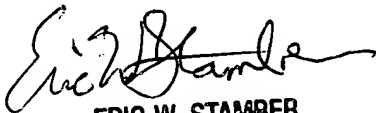
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

R.A.
March 4, 2003


ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600